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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,486	08/07/2003	Tomoyuki Ohzeki	FSF-031421	1098
37398	7590	10/17/2007		
TAIYO CORPORATION 401 HOLLAND LANE #407 ALEXANDRIA, VA 22314			EXAMINER CHEA, THORL	
			ART UNIT	PAPER NUMBER
			1795	
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			10/17/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/635,486

**Applicant(s)**

OHZEKI, TOMOYUKI

**Examiner**

Thorl Chea

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2, 5-6 and 8-11, 13-17, 19-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-6, 8-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This office action is responsive to the communication on July 20, 2007; Claims 2, 5-6, 8-11, 13-17, 19-21 are pending; claims 1, 3-4, 7, 12, 18 have been canceled.

#### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 2, 5-6, 8-11, 13-17, 19-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed fails to provide support "a particle size of 45 nm or less" raises the issue of new matter since "45 nm or less" encompassed the range of 0 to 45 nm" since the specification on page 13 fails to disclose such range, but 5 nm to 45 nm".

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2, 5-6, 8-11, 13-17, 19-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The use of the comparative language such as "shorter axis" and "longer axis" is indefinite since there is no based of comparison between the shorter axis or longer axis, i.e., the shorter axis is shorter than the longer axis, or shorter than the other axis?. The language "the needle crystal has a monodispersed size distribution in which a

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standard deviation of a length of the minor axis or major axis divided by a length of the minor axis or major axis, respectively, is not more than 50 %” is indefinite as it is unclear whether it means that a length of the minor axis divided by the length of the minor axis; or the a length of the minor axis divided by the length of the major axis or otherwise. There is no antecedent basis for the term “the minor axis or the major axis”.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 21, 2, 10-11, 13-17, 19-22 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yoshioka et al (US 2003/0235794A1). See the bisphenols reducing agent of formula ® on page 20, the non-photosensitive organic silver salt having silver behenate in the range of 40 mole % to 99 mole

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% wherein the particle size wherein the value obtained by dividing the standard deviation of the length of the short axis and the long axis respectively by the length of the short axis and long axis is preferably 100 % or less and more preferably 50 % or less, wherein the ratio of the long axis to short axis of 5 or less on page 19, [0121] to [0123] and page 20[0125] to [0128]; silver halide having iodide content of 80 mole % to 100 mole %; the amount thereof in the range of 1 mole % to 7 mole % on page 27, [0176] and [0182], and the size thereof in the range of 10 nm to 45 nm on page 27, [0180].

The material taught in Yoshioka et al has similar composition as claimed including the amount of silver halide having iodide content from 80 mole % to 100 mole %; the amount thereof in the range of 1 mole % to 7 mole %, except the non-photosensitive organic silver salt prepared in the presence of the photosensitive silver halide which has been preformed claimed in the present claimed invention. However, this preparation is related to the claiming of a material by a process. However, the material has same or similar composition; and the processing limitation fails to limit the composition of the material. Accordingly, the invention as claimed is either anticipated by or would have been found prima facie obvious over Yoshioka et al.

9. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshioka et al (US 2003/0235794A1) as applied to claims 21, 2-6, 19-20 above, and further in view of either Goto et al (US Patent No. 6,787,298) or Farid et al (US Patent No. 5,747,235).. See compound of Goto et al in columns 2-4, and Farid in the abstract and columns 16-18. The compound having property as claimed and useful as sensitizer for silver halide emulsion. It would have been obvious to the worker of ordinary skill in the art at the time the invention was

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made to use the sensitizer taught in Goto et al or Farid et al in the material of Yoshioka et al for same reason, and thereby provide a material as claimed.

***Response to Arguments***

10. Applicant's arguments filed July 20, 2007 have been fully considered but they are not persuasive for the reason set forth in the rejection above. The Declaration under 37 CFR 1.132 on July 20, 2007 fails to overcome the rejection. "(E)vidence of secondary considerations, such as unexpected results or commercial success, is irrelevant to 35 U.S.C 102 rejections and thus cannot overcome a rejection so based. In re Wiggins, 488 F.2d 538, 543, 179 USPQ 421, 425 (CCPA 1973).

***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tch   
2007-10-05

  
Thorl Chea  
Primary Examiner  
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